

REMARKS

Claims 1-27 remain pending in the present application.

Section 121 Restriction:

In response to the Examiner's restriction requirement under 35 U.S.C. § 121, Applicant elects Invention I **with traverse**. Applicant traverses the restriction requirement for the following reasons.

The Examiner states that Inventions I and II are related as process and apparatus for its practice. The Examiner asserts that the inventions are distinct because "the steps of the methods do not rely upon the specifics of the structure recited in the invention of Group II and accordingly, can be practiced without such system." The Examiner has failed to state a proper restriction requirement. M.P.E.P. § 806.05(e) states that the "burden is on the examiner to provide reasonable examples" of a materially different apparatus by which the process can be practiced. The Examiner provided no such examples. The Examiner only made a statement of conclusion that the steps of the method claims can be practiced without the system of the system claim. However, as noted in M.P.E.P. § 816, a "mere statement of conclusion is inadequate." Since the Examiner did not satisfy the burden required by M.P.E.P. §§ 806.05(e) and 816, the restriction requirement is improper. Applicant notes that claim 1 recites a "method for automatically generating purchase orders in a computer implemented procurement system". Claim 11 recites a system comprising a bus coupled to a processor and a memory coupled to said bus, said memory comprising instructions that when executed implement the same method as recited in claim 1. The Examiner has not shown how the computer-implement method of claim 1 can be practiced on a materially different apparatus from the system of claim 11. Therefore, the Examiner has failed to state a proper restriction requirement.

The restriction requirement is further improper because the Examiner has not stated a proper reason for insisting upon restriction as required by M.P.E.P. § 808, 808.02. Without giving any explanation or evidence, the Examiner merely states that the inventions “have acquired a separate status in the art because of their recognized divergent subject matter”. According to M.P.E.P. § 808.02, if the Examiner is relying on separate status in the art as the reason for insisting upon restriction, the Examiner must provide an explanation that indicates “a recognition of separate inventive effort by inventors.” Merely making the questionable statement that there is divergent subject matter does not provide an explanation of how the art would recognize separate inventive effort by inventors for the computer implemented method of claim 1 and the system of claim 11 that comprises program instructions to implement the same method. M.P.E.P. § 808.02 also states that “[s]eparate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.” The Examiner has provided no such evidence indicating that the art recognizes a separate status between the computer implemented method of claim 1 and the system of claim 11 that implements the same method. Therefore, the Examiner has further failed to state a proper restriction requirement.

Applicant also notes that M.P.E.P. 803 states that there “must be a serious burden on the examiner if restriction is required” (emphasis added). Applicant asserts that no serious burden exists in the present case. As the Examiner himself noted, both the method and the system have the same classification. Also, claims 1 and 11 recite the same method. Surely the Examiner is not asserting that the additional features of a bus, processor and memory for the system of claim 11 creates a serious burden for the Examiner beyond the method of claim 1.

Applicants also remind the Examiner that it is Office policy to not require restriction if the Examiner would assert an obviousness-type double patenting rejection if the different claim groups were presented in separate applications. *See, e.g.*, M.P.E.P. § 803.01.

For the reasons stated above, Applicant asserts that the restriction requirement is improper and withdrawal thereof is respectfully requested. Applicant requests examination of all pending claims.

CONCLUSION

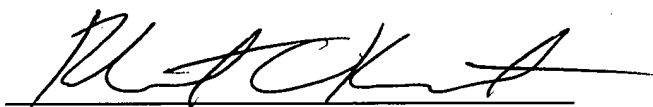
Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-90900/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,



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